Remarks/Arguments

In the Specification:

Paragraph [0001] has been amended to correct minor editorial problems (filling in blanks with the serial numbers of related, co-pending applications). The above-mentioned amendment to Paragraph [0001] was discussed with Examiner Thomas M. Ho in the telephone interview of November 15, 2004. Also discussed were questions concerning the prima facie case of anticipation (see Errors in Rejection below).

Errors in Rejection

The assignee respectfully asserts that:

It was erroneous to reject Claims 1-9, under 35 U.S.C. 102, as being anticipated by Kido, US Pat. No. 6,471,068 B1. A prima facie case of anticipation has not been established.

Argument regarding Claims 1-9, 35 U.S.C. 102 and lack of a prima facie case of anticipation:

As stated in MPEP 2131, to anticipate a claim, a reference must teach every element of the claim. "The identical invention must be shown in as complete detail as is contained in the ... claim." MPEP 2131, quoting *Richardson v. Suzuki Motor Co.* "The elements must be arranged as required by the claim, but ... identity of terminology is not required." MPEP 2131, citing *In re Bond*.

The following arguments point out some elements in the rejected claims which

are not described in the reference relied upon (Kido). This is contrary to the suggestion in the Office action that all claim elements are shown in Kido. Thus a prima facie case of anticipation has not been established. The rejection is unsupported by Kido and should be withdrawn.

Elements in the Rejected Claims Which Are Not Described in the References Relied On:

The following language from Claim 1 provides an example:

"...defining a limited number of privacy-related actions regarding said personally identifiable information;

constructing a rule for each circumstance in which one of said privacy-related actions may be taken or must be taken; ...."

Nothing like this is described in the reference the Office action relies on. To read this language from rejected Claim 1 in light of the specification, see the definition in the specification of the subject patent application (Page 9, or Paragraph 39 of the published version):

> Personally Identifiable Information (PII) is defined as "Any information relating to an identified or identifiable natural person ('data subject')." An identifiable person is one who can be "identified, directly or indirectly, in particular by reference to an identification number or to one or more factors specific to his physical, physiological, mental, economic, cultural or social category." (From the EU Data Directive.)

See also the example of "a limited set of privacy-related actions: access, disclose, release, notify, utilize, update, withdraw consent, give consent, delete, anonymize, depersonalize, and repersonalize." Specification Page 4, or Paragraph 0010 of the published version. See also FIG. 14 concerning privacy-related actions.

Concerning "privacy-related actions regarding said personally identifiable information" of rejected Claim 1, the Examiner cites a portion of Kido that states: "If this execution object is determined to be valid, access thereto is allowed/implemented (block 417), and then the present procedure is terminated (block 421)." Kido, Col. 15, Lines 6-13. Actually, Kido's execution object contains *impersonal* information such as "a currency exchange rate, an accounting rule, a tax law or the like." See Kido, Col. 1, Lines 25-26, Col. 3, Lines 30-32, Col. 15, Lines 53-55.

Returning to rejected Claim 1, concerning "constructing a rule for each circumstance in which one of said privacy-related actions may be taken or must be taken," the Examiner cites a portion of Kido that merely states: "In the field of highly secured information processing, such as an accounting calculation or an electronic commerce, it has been strongly desired to provide an assurance of credibility of rule sets and data that are embedded into business objects (or classes) for use in such information processing." Kido, Col. 1, Lines 15-20. Apparently Kido is describing *impersonal* "data that are frequently changed to reflect day-to-day transactions, including currency exchange rates and

accounting rules." See Kido, Col. 1, Lines 23-26.

The Office action at Page 3 mistakenly asserts that Kido describes "personally identifiable information" in a section describing a digital signature. The Office action cites a description of a digital signature "to confirm that the data is not corrupted." Kido, Col. 12, Lines 1-15. Again, Kido is describing impersonal data such as currency exchange rates. Kido teaches nothing about "personally identifiable information" or personal privacy. Kido's text contains none of the following terms: "personally identifiable information," "personal information," "privacy-related action," "privacy," or "private."

The following language from Claim 2 provides another example of elements in the rejected claims which are not described in the reference relied upon:
"... output is selected from the group consisting of
authorizing said privacy-related action,
authorizing said privacy-related action, plus specifying one or more tasks,
and denying said request but also suggesting what must be done to have said request approved."

The following language from rejected Claim 3 provides another example of elements in the rejected claims which are not described in Kido:
"specification of at least one additional action that must be taken."

Concerning the above-quoted language of rejected Claims 2 and 3, the Office

action cites a section of Kido that merely describes: "(a) receiving from an application an object access request including object specifying information; (b) accessing the first object stored in said first storage means based on said first path information ...."Kido Col. 5, lines 13-15. The Office action at Pages 3-4 assumes the existence of a hypothetical error message "suggesting what must be done" to have a request approved, or specifying "at least one additional action that must be taken." However, no such error message is described in Kido.

To summarize, the above-quoted elements of rejected Claims 1-3 are not described in the reference the Office action relies on. No such elements are shown in as complete detail as is contained in the rejected claims 1-3. No such elements are arranged as required by the rejected claims 1-3. Thus a prima facie case of anticipation has not been established.
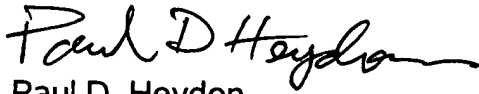
The points made above, concerning rejected Claims 1-3, also apply to rejected Claims 4-9, which contain language similar to above-quoted language of Claims 1-3. For example, consider rejected Claims 4-6 to a system, in light of FIG. 8 and the written description at Specification Pages 26-27, or Paragraph 0093 of the published version. Elements of rejected Claims 4-6 are not described in the reference the Office action relies on. Thus a prima facie case of anticipation has not been established.

Assignee respectfully submits that the rejection of Claims 1-9 should be withdrawn, and requests that a timely Notice of Allowance be issued in this case.

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Amendment and Reply to Office action of November 5, 2004

Respectfully submitted,

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